

REMARKS

Claims 1, 2, 12-15, 18-21, 26, 27, 32, 33, 38, 39, and 44-51 are pending in this application. Claims 3-11, 16-17, 22-25, 28-31, 34-37, and 40-43 were previously canceled. Claims 46-51 are added. Claims 12, 12-15, and 18-21 are amended. Claims 1 and 18-21 are the independent claims.

Claim Rejections under 35 U.S.C. §101

The Examiner rejects claims 1-2 and 12-15 under 35 U.S.C. § 101 alleging they are drawn to non-statutory subject matter. In particular, the Examiner asserts that “the scope of the presently claimed computer-readable medium can range from paper on which the program is written, to a program simply contemplated and memorized by a person.” Accordingly, the Examiner asserts that claims 1-2 and 12-15 include scope which is non-statutory. Although the Applicants do not agree that the claims 1-2 and 12-15 are directed to non-statutory subject matter, the Applicants have amended claims 1-2 and 12-15 to recite a “**tangible** computer-readable medium.” Accordingly, the Applicants submit claims 1-2 and 12-15, as amended, no longer suffer the alleged defect. In light of the amendments to claims 1-2 and 12-15, the Applicants respectfully request the rejection of claims 1-2 and 12-15 under 35 U.S.C. § 101 be withdrawn.

Claim Rejections under 35 U.S.C. §103(a)

Claims 1, 2, 12-15, 18-21, 26, 27, 32, 33, 38, 39, 44 and 45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication 2002/0145702 to Kato et al. (“Kato”) in view of U.S. Patent 7,054,545 to Ando et al. (“Ando”) in view of

U.S. Patent Publication 2006/0188223 to Ikeda et al. ("Ikeda") in view of U.S. Patent 6,529,683 to Mori et al. ("Mori"). The Applicants respectfully traverse.

Initially, the Applicants note that the Examiner relied on the combination of Kato, Ando, **Ikeda**, and Mori for disclosing each of the features recited in the claims. However, for at least the reasons set forth below, the Applicants submit the combination of Kato, Ando, **Ikeda**, and Mori is improper at least because Ikeda does not qualify as prior art under 35 U.S.C. § 102(a), (b), or (e). Accordingly, the Applicants submit Ikeda is not usable for rejecting claims under 35 U.S.C. § 103.

The earliest date of publication attributable to the Ikeda document is the August 24, 2006 PCT publication date. However, this does not antedate the filing date of the instant application (January 29, 2004). Accordingly, Ikeda does not qualify as prior art under 35 U.S.C. § 102(a) or (b).

In order to qualify as prior art under 35 U.S.C. § 102(e) the Examiner must show

the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States **before the invention by the applicant for patent** or (2) a patent granted on an application for patent by another filed in the United States **before the invention by the applicant for patent**, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the **English language**.

As applied to Ikeda, the Applicants note that the PCT filing date and the published application date are January 30, 2004 and August 24, 2006, neither of which antedates the filing date of the instant application (January 29, 2004). Accordingly, the Applicants submit that the published Ikeda document does not qualify as prior art under 35 U.S.C. § 102(e) and least because the published Ikeda document does not

show the invention was described in “(1) an application for patent, published under section 122(b), by another filed in the United States **before the invention by the applicant for patent** or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty **in the English language.**”

Additionally, the Applicants direct the Examiner to MPEP § 706.02(f)(1), example 5. In that example, the MPEP illustrates a case where a reference based on the national stage (35 U.S.C. § 371) of an international application is filed on or after November 29, 2000 and which was not published in English under PCT Article 21(2). According to this section of the MPEP

All references, whether the WIPO publication, the U.S. patent application publication or the U.S. patent, of an international application (IA) that was filed on or after November 29, 2000 but was not published in English under PCT Article 21(2) have no 35 U.S.C. 102 (e) prior art date at all. **According to 35 U.S.C. 102 (e), no benefit of the international filing date (nor any U.S. filing dates prior to the IA) is given for 35 U.S.C. 102 (e) prior art purposes if the IA was published under PCT Article 21(2) in a language other than English.** regardless of whether the international application entered the national stage. Such references may be applied under 35 U.S.C. 102 (a) or (b) as of their publication dates, but never under 35 U.S.C. 102 (e).

Furthermore, this section also states:

If the IA properly claimed the benefit of to any earlier-filed U.S. application (whether **provisional** or nonprovisional), **there would still be no 35 U.S.C. 102 (e) date for all the references.**

The Applicants have reviewed PCT/JP04/00891 and note that this application was filed after November 29, 2000 and was not published in English. In light of the above

disclosure, the Applicants submit the Ikeda document does not have a 102(e) date.

Furthermore, the Applicants submit that the claimed benefit to Provisional Application No. 60/443,876 does not cure this defect.¹

For at least the reasons set forth above, the Applicants submit Ikeda does not qualify as prior art under 35 U.S.C. § 102(a), (b), or (e) and is therefore not usable for rejecting claims under 35 U.S.C. § 103.

On page 6 of the Office Action, the Examiner admits that neither Kato nor Ando disclose “the at least one still picture unit including at least one still picture and associated graphic data,” as recited in claim 1. Accordingly, the Applicants submit the Examiner cannot rely on either of these references to disclose the instant feature. Furthermore, the Examiner has not asserted that the Mori document discloses “the at least one still picture unit including at least one still picture and associated graphic data,” as recited in claim 1. Therefore, because the Examiner has not shown the instant feature is disclosed in the Mori document, and because the instant feature is not disclosed by either Kato or Ando, and because Ikeda does not qualify as prior art usable for rejecting claims under 35 U.S.C. § 103, the Applicants submit the Examiner has failed to establish that the combination of Kato, Ando, Ikeda, and Mori disclose, at least, “the at least one still picture unit including at least one still picture and associated graphic data,” as recited in claim 1. Accordingly, the Applicants submit the Examiner has failed to show that claim 1 is *prima facie* obvious over the combination of Kato, Ando, Ikeda, and Mori.

For at least the reasons given above, the Applicants respectfully request the rejection of claim 1, and all claims which depend thereon, under 35 U.S.C. § 103 as being obvious over the combination of Kato, Ando, Ikeda, and Mori be withdrawn.

¹ See MPEP § 706.02(f)(1)(III) flowcharts as well.

For somewhat similar reasons, the Applicants respectfully request the rejection of claims 18-21, and all claims which depend thereon, under 35 U.S.C. § 103 as being obvious over the combination of Kato, Ando, Ikeda, and Mori be withdrawn.

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CONCLUSION

In view of the above remarks and amendments, Applicants respectfully submit that each of the rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

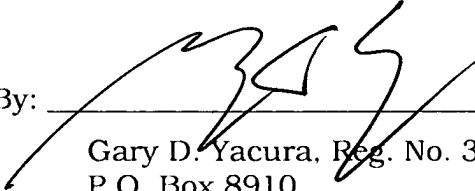
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary D. Yacura at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By: _____


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